

REMARKS

Claims 1-3, 6-7 and 9-13 are pending in the present application. Applicant respectfully requests reconsideration of the present claims in view of the following remarks.

I. Formal Matters:

February 12, 2010 Personal Interview

Applicant thanks Examiner Qazi for discussing the present application with Applicant's representative, Mr. James Withers, during a February 12, 2010 telephone interview.

As discussed during the February 12, 2010 telephone interview and further below, the art of record fails to make obvious Applicant's claimed invention as embodied in pending claims 1-3, 6-7 and 9-13. Further, as discussed during the February 12, 2010 telephone interview and below, the finality of the present office action should be withdrawn given the uncertainty of the status of the rejections in the October 15, 2009 final Office Action.

Premature Finality of the October 15, 2009 Final Office Action

Applicant first notes that on the "Office Action Summary", the October 15, 2009 Office Action is described as a non-final office action. More importantly, from page 8, line 19 to page 9, line 3 of the October 15, 2009 Office Action, Examiner Qazi describes a compound that allegedly "has been disclosed by the prior art." However, the compound is not found in any reference cited by Examiner Qazi. This portion of the October 15, 2009 Office Action is supposed to be directed to the rejection of claims 1-4, 6-7 and 9-13 in view of Lahm; however, as discussed in Applicant's July 20, 2009 Amendment and Response (see, page 13, lines 10-14 of Applicant's July 20, 2009 Amendment and Response) and during the February 12, 2010 telephone interview, the teaching of Lahm is not related in any way to the compound disclosed on page 9 of the October 15, 2009 Office Action.

Applicant respectfully submits that a clear issue has not been developed between Examiner Qazi and Applicant in view of the compound disclosed from page 8, line 19 to page 9, line 3 of the October 15, 2009 Office Action. As stated in §706.07 of the MPEP:

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

Applicant respectfully submits that the finality of the October 15, 2009 Office Action should be withdrawn in order to (1) clarify what rejections, if any, should remain in the case, (2) determine the source of the compound disclosed on page 9 of the October 15, 2009 Office Action, and (3) determine if the source is prior art to the present invention.

For at least the reasons given above, Applicant respectfully requests withdrawal of the finality of the October 15, 2009 Office Action.

Co-Pending Applications

As discussed in Applicant's July 20, 2009 Amendment and Response, Applicant is not aware of any co-pending application(s) that is "material" to examination of the present application.

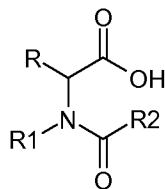
II. Prior Art Rejections:

Rejection of Previously Presented Claims 1-4, 6-7 and 9-13 Under 35 U.S.C. §103(a) In View of U.S. Patent Application Publication No. 2001/0031890 (Riermeier)

Previously presented claims 1-4, 6-7 and 9-13 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent Application Publication No. 2001/0031890 to Riermeier et al. (hereinafter, "Riermeier"). This rejection is respectfully traversed for at least the reasons given in Applicant's July 20, 2009 Amendment and Response, the reasons discussed during the February 12, 2010 telephone interview, and the reasons provided below.¹

As discussed in Applicant's July 20, 2009 Amendment and Response, the teaching of Riermeier is directed to processes for racemization of enantiomerically pure compounds having the formula below:

¹ It should be noted that claim 4 was previously cancelled in Applicant's July 20, 2009 Amendment and Response.



wherein each of R, R1, and R2 is independently selected from a hydrogen and/or alkyl, alkenyl, alkynyl, aryl and/or heteroaryl radical, where alkyl can be an aliphatic carbon group having 1 to 18 carbon atoms, which can be linear, branched and/or alternatively cyclic, and alkenyl or alkynyl is a mono- or polyunsaturated aliphatic group having 2 to 18 carbon atoms, which can be branched or nonbranched, and aryl is a five-, six- or seven-membered aromatic ring, where this ring can be fused and can contain 0 to 3 heteroatoms such as N, O, S, comprising 4 to 14 carbon atoms, and in this case the alkyl and the aryl group can optionally carry up to six further substituents which independently of one another are hydrogen, alkyl, O-alkyl, OCO-alkyl, O-aryl, aryl, fluorine, chlorine, bromine, iodine, OH, CF₃, NO₂, NO, Sialkyl₃, CN, COOH, CHO, SO₃H, NH₂, NH-alkyl, N-alkyl₂, PO-alkyl₂, SO₂-alkyl, SO-alkyl, NHCO-alkyl, CONH₂, CO-alkyl, COO-alkyl, NHCOH, NHCOO-alkyl, CO-aryl, COO-aryl, POaryl₂, PO₃H₂, PO(O-alkyl)₂, or SO₃-alkyl.

In order for one skilled in the art, given the teaching of Riermeier, to contemplate compounds similar to Applicant's claimed compounds, one skilled in the art would need to (1) select R2 to be a heterocyclic group; (2) select R1 to be a phenyl group; (3) select a Si-alkyl₃ substituent for the phenyl group; and (4) substitute the a Si-alkyl₃ substituent at the ortho position on the phenyl group. Each of these specific selections would need to be made from hundreds of alternative selections from the numerous possible "R" groups and possible substituents described above. Applicant submits that the teaching of Riermeier does not suggest or guide one skilled in the art to make the above specific selections.

More importantly, even if one skilled in the art were to make the each of the four above-mentioned specific selections from the hundreds of alternative selections, one skilled in the art would still not arrive at the compounds of Applicant's claimed invention. The resulting structure would comprise the moiety -CRCOOH, which is not present in Applicant's compounds of formula (I). In particular, R¹ as recited in Applicant's independent claim 1 would have to be

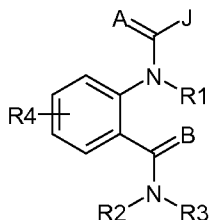
the moiety –CRCOOH. However, as recited in Applicant’s independent claim 1, R¹ cannot be the moiety –CRCOOH. R¹ can be a substituted alkyl group, but when substituted, the optional substituent is limited to one of the following substituents: halogen, hydroxy, cyano, methoxycarbonyl, ethoxycarbonyl, methoxy, ethoxy, methylsulfonyl, ethylsulfonyl, difluoromethoxy, trifluoromethoxy and trifluorothiomethoxy.

For at least the reasons discussed in Applicant’s July 20, 2009 Amendment and Response, the reasons discussed during the February 12, 2010 telephone interview, and the reasons given above, it is respectfully submitted that the teaching of Riermeier fails to make obvious Applicant’s claimed invention as embodied in independent claim 1. Since claims 2-3, 6-7 and 9-13 depend from independent claim 1 and recite further claim features, the teaching of Riermeier also fails to make obvious Applicant’s claimed invention as embodied in dependent claims 2-3, 6-7 and 9-13. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection of Previously Presented Claims 1-4, 6-7 and 9-13 Under 35 U.S.C. §103(a) In View of U.S. Patent No. 6,747,047 (Lahm)

Previously presented claims 1-4, 6-7 and 9-13 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent No. 6,747,047 issued to Lahm et al. (hereinafter, “Lahm”). This rejection is respectfully traversed for at least the reasons given in Applicant’s July 20, 2009 Amendment and Response, the reasons discussed during the February 12, 2010 telephone interview, and the reasons provided below.²

As discussed in Applicant’s July 20, 2009 Amendment and Response, the teaching of Lahm is directed to compounds having the generic formula below:



wherein A, B, J and R¹-R⁴ are as defined in Lahm from column 2, line 14 to column 4, line 30.

² As noted above, claim 4 was previously cancelled in Applicant’s July 20, 2009 Amendment and Response.

The teaching of Lahm fails to disclose, teach or suggest Applicant's compounds of formula (I) as recited in independent claim 1. In particular, the teaching of Lahm requires the disclosed compounds to comprise a moiety corresponding to $-C(B)N(R_2)R_3$. Applicant's compounds of formula (I) as recited in independent claim 1 do not include a moiety corresponding to $-C(B)N(R_2)R_3$.

There is no teaching or suggestion in the teaching of Lahm that would have motivated one of skill in the art to provide compounds that do not include the $-C(B)N(R_2)R_3$ group. To suggest otherwise would ignore the teaching of Lahm.

For at least the reasons discussed in Applicant's July 20, 2009 Amendment and Response, the reasons discussed during the February 12, 2010 telephone interview, and the reasons given above, it is respectfully submitted that the teaching of Lahm fails to make obvious Applicant's claimed invention as embodied in independent claim 1. Since claims 2-3, 6-7 and 9-13 depend from independent claim 1 and recite further claim features, the teaching of Lahm also fails to make obvious Applicant's claimed invention as embodied in dependent claims 2-3, 6-7 and 9-11. Accordingly, withdrawal of this rejection is respectfully requested.

III. Conclusion:

For at least the reasons given above, Applicant submits that claims 1-3, 6-7 and 9-13 define patentable subject matter. Accordingly, Applicant respectfully requests allowance of these claims.

Should Examiner Qazi believe that further action is necessary to place the application in better condition for allowance, Examiner Qazi is respectfully requested to contact Applicant's representative at the telephone number listed below.

Amendment and Response
Serial No. 10/509,607

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Respectfully submitted,
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